

# TRANSMITTAL FORM

(To be used for all correspondence after initial filing)

Application Number	10/622,182		
Filing Date	July 16, 2003		
First Named Inventor	Jeffrey Van Ness		
Art Unit	1645		
Examiner Name			
Attorney Docket No.	780068.416D1		

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Fee Transmittal Form Fee Attached Amendment/Response After Final Affidavits/declaration(s) Extension of Time Request Express Abandonment Request Information Disclosure Statement; Form PTO-1449 A 6 Cited References Certified Copy of Priority Document(s) Response to Missing Parts under 37 C.F.R. 1.52 or 1.53 Response to Missing Parts/Incomplete Application			Drawing(s) Request for Corrected Filing Receipt Licensing-related Papers Petition Petition to Convert to a Provisional Application Power of Attorney, Revocation, Change of Correspondence Address Declaration Statement under 37 CFR 3.73(b) Terminal Disclaimer Request for Refund		CD(s), Number of CD(s)  After Allowance Communication to Group Appeal Communication to Board of Appeals and Interferences Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) Proprietary Information Status Letter Return Receipt Postcard Additional Enclosure(s) (please identify below):
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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**PATENT** 

United States Postal Service as first-class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date () 23, 2004

Lawrence Teague

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicants** 

Jeffrey Van Ness et al.

Application No.

10/622,182

Filed

July 16, 2003

For

METHODS AND COMPOSITIONS FOR DETERMINING THE

SEQUENCE OF NUCLEIC ACID MOLECULES

Art Unit

: 1645

Docket No.

780068.416D1

Date-

January 23, 2004

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

#### INFORMATION DISCLOSURE STATEMENT

#### Commissioner for Patents:

In accordance with 37 C.F.R. §§ 1.56 and 1.97 through 1.98, applicants wish to make known to the Patent and Trademark Office the references set forth on the attached form PTO-1449. This application is a divisional and relies, under 35 U.S.C. § 120, on the earlier filing date of prior application USAN 09/855,999, filed May 14, 2001; which is a continuation of USAN 08/898,180, filed July 22, 1997; which is a continuation-in-part of USAN 08/786,835, filed January 22, 1997. The references listed on pages 2-9 of the attached forms PTO-1449 were submitted to and/or cited by the Office in these prior applications and, therefore, are not required

to be provided in the present application. If the Examiner wishes copies will be provided upon request. However, the six references listed on page 1 of the attached forms PTO-1449 were not previously submitted to and/or cited by the Office, and copies are enclosed herewith.

As to any reference supplied, applicants do not admit that it is "prior art" under 35 U.S.C. §§ 102 or 103, and specifically reserve the right to traverse or antedate any such reference, as by a showing under 37 C.F.R. § 1.131 or other method. Although the aforesaid references are made known to the Patent and Trademark Office in compliance with applicants' duty to disclose all information they are aware of which is believed relevant to the examination of the above-identified application, applicants believe that their invention is patentable.

Please acknowledge receipt of this Information Disclosure Statement and kindly make the cited references of record in the above-identified application.

Applicants believe this Information Disclosure Statement has been timely filed, however, the Director is authorized to charge any fee due by way of this Information Disclosure Statement to our Deposit Account No. 19-1090.

Respectfully submitted,

Seed Intellectual Property Law Group PLLC

Qing Lin, Ph.D.

Registration No. 53,937

QXL:ljt Enclosures:

> Postcard Tranmittal Form Form PTO-1449 (9 Sheets) Cited References (6)

701 Fifth Avenue, Suite 6300 Seattle, Washington 98104-7092

Phone: (206) 622-4900 Fax: (206) 682-6031

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	AC	5,436,130	07/25/95	Mathies e	et al.	435	6		
	AD	6,312,893	11/06/01	Van Ness	et al.	435	6		
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APPLICANTS

Jeffrey Van Ness et al.

FILING DATE July 16, 2003 GROUP ART UNIT 1645

#### **U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	ВА	4,650,750	03/17/87	Giese	435	7	
	вв	4,709,016	11/24/87	Giese	530	389	
	вс	4,762,779	08/09/88	Snitman	435	6	
	BD	4,775,619	10/04/88	Urdea	435	6	
	BE	4,942,124	07/17/90	Church	435	6	
_	BF	4,962,020	10/09/90	Tabor et al.	435	6	
	ВG	4,965,349	10/23/90	Woo et al.	536	27	
	вн	4,994,372	02/19/91	Tabor et al.	435	6	
	ві	4,997,928	03/05/91	Hobbs, Jr.	536	27	
	BJ	5,118,605	06/02/92	Urdea	435	6	

#### FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANS	LATION
	DOCOMENT NOMBER	DATE	COUNTRI	YES	NO
вк	CA 2062454 A1	09/08/92	Canada		
BL	EP 127 154 A2	12/05/84	ЕРО		
вм	EP 251 786 A2	01/07/88	ЕРО		
BN	EP 300 730 A1	01/25/89	ЕРО		
во	EP 360 940 A2	04/04/90	ЕРО		

#### OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

ВР	Aebersold et al., "Design, synthesis, and characterization of a protein sequencing reagent yielding amino acid derivatives with enhanced detectability by mass spectrometry," <i>Protein Science 1</i> (4):494-503, April 1992.
BQ	Amankwa and Kuhr, "Trypsin-Modified Fused-Silica Capillary Microreactor for Peptide Mapping by Capillary Zone Electrophoresis," <i>Anal. Chem.</i> 64:1610-1613, 1992.
BR	Baldwin et al., "Synthesis of a Small Molecule Combinatorial Library Encoded with Molecular Tags," <i>J. Am. Chem. Soc. 117</i> :5588-5589, 1995. (+Supplementary Material, 21 pages)

**EXAMINER** 

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APPLICATION NO. 10/622,182

APPLICANTS

Jeffrey Van Ness et al.

FILING DATE July 16, 2003 **GROUP ART UNIT** 1645

#### **U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	CA	5,135,870	08/04/92	Williams et al.	436	173	
	СВ	5,149,625	09/22/92	Church et al.	435	6	
	СС	5,262,536	11/16/93	Hobbs, Jr.	546	25	
	CD	5,266,466	11/30/93	Tabor et al.	435	91.5	
	CE	5,288,644	02/22/94	Beavis et al.	436	94	
	CF	5,290,925	03/01/94	Fino	536	25.32	
	CG	5,292,873	03/08/94	Rokita et al.	536	24.3	
	СН	5,302,509	04/12/94	Cheeseman	435	6	
	CI	5,324,631	06/28/94	Helentjaris et al.	435	6	
	CJ	5,346,670	09/13/94	Renzoni et al.	422	52	

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	DOCOMENT NOMBER	DATE	CONTRI	YES	NO
СК	EP 401 821 A1	12/12/90	EPO		
CL	EP 502 595 A2	09/09/92	ЕРО		
СМ	EP 514 927 A1	11/25/92	ЕРО		
CN	EP 539 343 A1	04/28/93	ЕРО		
со	EP 639 647 A2	02/22/95	ЕРО		

#### OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

CP	Borchardt and Still, "Synthetic Receptor Binding Elucidated with an Encoded Combinatorial
	Library," J. Am. Chem. Soc. 116:373-374, 1994.
CQ	Brown et al., "A single-bead decode strategy using electrospray ionization mass spectrometry and a new photolabile linker: 3-Amino-3-(2-nitrophenyl)propionic acid," <i>Molecular Diversity 1</i> :4-12, 1995.
CR	Ching et al., "Polymers as Surface-Based Tethers with Photolytic Triggers Enabling Laser-Induced Release/Desorption of Covalently Bound Molecules," <i>Bioconjugated Chemistry</i> 7(5):525-528, 1996.

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\* EXAMINER:

Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant(s).

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ATTY. DOCKET NO. 780068.416D1 APPLICATION NO. 10/622,182

APPLICANTS

Jeffrey Van Ness et al.

FILING DATE
July 16, 2003

GROUP ART UNIT 1645

#### **U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	DA	5,360,819	11/01/94	Giese	514	538	
	DB	5,403,708	04/04/95	Brennan et al.	435	6	·
	DC	5,409,811	04/25/95	Tabor et al.	435	6	
	DD	5,451,463	09/19/95	Nelson et al.	428	402	
	DE	5,516,931	05/14/96	Giese et al.	560	59	
	DF	5,547,835	08/20/96	Köster	435	6	
	DG	5,602,273	02/11/97	Giese et al.	560	60	
	DН	5,604,097	02/18/97	Brenner	435	6	
	DI	5,604,104	02/18/97	Giese et al.	435	7.1	
	DJ	5,610,020	03/11/97	Giese et al.	435	7.1	

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	DOCUMENT NUMBER	DATE	COUNTRY	TRANS	LATION
	DOCOMENT NOMBER	DATE	COUNTRY	YES	NO
DK	EP 711 362 B1	05/15/96	EPO ·		
DL	JP 06-289018	10/18/94	JPO (+WPI Abstract No. 95-001707)		
DM	WO 89/12694	12/28/89	WIPO		
DN	WO 90/13666	11/15/90	WIPO		
DO	WO 92/02528	02/20/92	WIPO		

#### OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	OP	Ching et al., "Surface Chemistries Enabling Photoinduced Uncoupling/Desorption of
		Covalently Tethered Biomolecules," J. Org. Chem. 61(11):3582-3583, May 31, 1996.
С	DQ	Church and Kieffer-Higgins, "Multiplex DNA Sequencing," Science 240:185-188, 1988.
Г	OR	Church et al., "New Technologies For Genome Sequencing and Analysis," in <i>DOE Human Genome Program Contractor-Grantee Workshop V</i> , Sante Fe, New Mexico, January 28-February 1, 1996, available NTIS, CONF-960143, 1996, p. 51.

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APPLICATION NO. 10/622,182

APPLICANTS

Jeffrey Van Ness et al.

FILING DATE July 16, 2003 GROUP ART UNIT 1645

#### **U.S. PATENT DOCUMENTS**

*EXAMINER . INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	EA	5,622,824	04/22/97	Köster	435	6	
<u></u>	EB	5,635,400	06/03/97	Brenner	435	320.1	
	EC	5,650,270	07/22/97	Giese et al.	435	6	
	ED	5,654,413	08/05/97	Brenner	536	22.1	
	EE	5,674,716	10/07/97	Tabor et al.	435	91.1	
	EF	5,691,141	11/25/97	Köster	435	6	
	EG	5,695,934	12/09/97	Brenner	435	6	
	ЕН	5,700,921	12/23/97	Westling et al.	536	22.1	
	EI	5,728,526	03/17/98	George, Jr. et al.	435	6	
	EJ	5,763,175	06/09/98	Brenner	435	6	

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EK	WO 92/02638	02/20/92	WIPO		
EL	WO 92/10587	06/25/92	WIPO		
ЕМ	WO 93/20233	10/14/93	WIPO		
EN	WO 93/20236	10/14/93	WIPO		
EO	WO 93/21340	10/28/93	WIPO		

#### OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	EP	Cobb and Novotny, "High-sensitivity peptide mapping by capillary zone electrophoresis and microcolumn liquid chromatography, using immobilized trypsin for protein digestion," <i>Anal. Chem.</i> 61:2226-2231, 1989.
	EQ	Colombo, "Liquid-phase synthesis of naturally occurring peptides, II. Syntheses of three mast cell degranulating tetradecapeptide amides from wasp venoms," <i>Hoppe Seylers Z. Physiol. Chem.</i> 362(10):1393-1403, October 1981.
	ER	Covey et al., "The determination of protein, oligonucleotide and peptide molecular weights by ion-

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ATTY. DOCKET NO. APPLICATION NO. 780068.416D1 10/622,182

APPLICANTS

Jeffrey Van Ness et al.

# INFORMATION DISCLOSURE STATEMENT

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FILING DATE GROUP ART UNIT
July 16, 2003 1645

#### **U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	FA	5,821,058	10/13/98	Smith et al.	435	6	
	FB	5,851,765	12/22/98	Köster	435	6	
	FC	5,856,097	01/05/99	Pinkel et al.	435	6	
	FD	5,863,722	01/26/99	Brenner	435	6	
	FE	5,872,003	02/16/99	Köster	435	283.1	
	FF	5,908,745	06/01/99	Mirzabekov et al.	435	6	:
	FG	5,952,654	09/14/99	Giese	250	288	
	FH	5,962,223	10/05/99	Whiteley et al.	435	6	
	FI	6,013,431	01/11/00	Söderlund et al.	435	5	
	FJ	6,027,890	02/22/00	Ness et al.	435	6	

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FK	WO 94/08051	04/14/94	WIPO		
FL	WO 94/16101	07/21/94	WIPO		
FM	WO 94/21822	09/29/94	WIPO		
FN	WO 94/28418	12/08/94	WIPO		
FO	WO 95/04160	02/09/95	WIPO		

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	FP	Geysen et al., "Isotope or mass encoding of combinatorial libraries," <i>Chemistry &amp; Biology</i> 3(8):679-688, 1996.
i	FQ	Giese et al., "Electophore Mass Labels For TOF-MS DNA Sequencing," in <i>Proceedings of the 44<sup>th</sup> ASMS Conference on Mass Spectrometry and Allied Topics</i> , Portland, Oregon, May 12-16, 1996, p. 673.
	FR	Giese, "Electrophoric release tags: ultrasensitive molecular labels providing multiplicity," Trends in Analytical Chemistry 2(7):166-168, 1983.

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ATTY. DOCKET NO. 780068.416D1

APPLICATION NO. 10/622,182

APPLICANTS

Jeffrey Van Ness et al.

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July 16, 2003

GROUP ART UNIT 1645

# **U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	GA	6,033,909	03/07/00	Uhlmann et al.	435	375	
	GB	6,087,095	07/11/00	Rosenthal et al.	435	6	
	GC	6,087,186	07/11/00	Cargill et al.	436	518	
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GF	WO 95/11961	05/04/95	WIPO		
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GH	WO 95/25737	09/28/95	WIPO		
GI	WO 95/28640	10/26/95	WIPO		
GJ	WO 96/00378	01/04/96	WIPO		
GK	WO 96/22966	08/01/96	WIPO		
GL					

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	GM	Greenberg and Gilmore, "Cleavage of Oligonucleotides from Solid-Phase Supports Using of Nitrobenzyl Photochemistry," <i>J. Org. Chem.</i> 59:746-753, 1994.
	GN	Greenberg, "Photochemical Cleavage of Oligonucleotides From Solid Phase Supports," <i>Tetrahedron Letters</i> 34(2):251-254, 1993.
	GO	Hignite, "Nucleic Acids and Derivatives," in <i>Biochemical Applications of Mass Spectrometry, First Supplementary Volume</i> , Waller et al., (eds.), John Wiley & Sons, New York, 1981, pp.527-566.
	GP	Holmes and Jones, "Reagents for Combinatorial Organic Synthesis: Developent of New o-Nitrobenzyl Photalabile Linker for Solid Phase Synthesis," J. Org. Chem. 60:2318-2319, 1995. (+Supplementary Material, 7 pages)
<u></u>	GQ	Jacobson et al., "Applications of Mass Spectrometry to DNA Sequencing," Genetic Analysis Techniques and Applications 8(8):223-229, 1991.

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		carboxylic acid grou at the 5' terminus," <i>Nucleic Acids Research 15</i> (7):2891-2909, 193 Little et al., "Rapid Sequencing of Oligonucleotides by High-Resolution Mass							<u> </u>		
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